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CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Planet E-Shop, Inc.

Serial No. 76113552

Dennis T. Griggs of Griggs, Bergen & Johnston for Planet E-Shop, Inc.

Angela M. Micheli, Trademark Examining Attorney, Law Office 108 (David E. Shallant, Managing Attorney).

Before Walters, Bottorff and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Planet E-Shop, Inc. has filed an application to register the mark PLANET E SHOP on the Principal Register for "promoting and marketing the goods and services of others through on-line ordering and cataloging those goods and services, namely, home shopping, business-to-consumer and business-to-business marketplace services featuring a variety of goods and services of others offered via

broadcast television, cable television, satellite television, interactive electronic communications networks and a worldwide global computer network."¹

In an amendment submitted before its appeal brief, but after the examining attorney denied applicant's request for reconsideration, applicant disclaimed "E SHOP" apart from its mark as a whole. The examining attorney has not expressly accepted this disclaimer, but because it complies with the requirement made by the examining attorney and she did not object to it in her brief, we consider the disclaimer to be part of the record.²

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark ESHOP, previously registered for "interactive electronic retailing and on-line ordering services, namely, shop-at-home services and virtual retail store services accessed through computers, personal digital assistants, and interactive televisions, featuring products and services for consumer and business use,"³ that, if used on or in

¹ Serial No. 76/113,552, in International Class 35, filed August 21, 2000, based on an allegation of a bona fide intention to use the mark in commerce.

² We note, however, that disclaimer of E SHOP does not obviate the refusal on the ground of likelihood of confusion.

³ Registration No. 1,995,850 issued August 20, 1996, to EShop, Inc., in International Class 42. The registration has been assigned to Microsoft Corporation. Sections 8 and 15 affidavits accepted and acknowledged, respectively.

connection with applicant's services, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We consider, first, the services involved in this case. We note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the

evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The examining attorney contends that that the respective services are essentially identical. She notes that both recitations of services are broadly written and, therefore, that the scope of the goods and services available through the respective services is identical. Applicant acknowledges that the recited services "appear to be closely related." Applicant submitted an excerpt from

its Internet web site and a list of the goods and services it offers in connection with its identified services. Applicant noted that its recited services are classified in a different class from the services in the cited registration; and applicant argued that "it is not possible to make a meaningful comparison of the respective services" because the recitation of services in the registration provides "no specifics or details." [Brief p. 8.] Applicant argued, further, that customers of either applicant or registrant must be sophisticated because they must be computer literate and have access to a computer in order to use either applicant's or registrant's services, and that such consumers will exercise care in on-line transactions.

We agree with the examining attorney that the services as recited in the application and registration are essentially the same. Both parties are offering goods and services for sale electronically through various media; neither party has restricted the nature of the goods and services it offers; and both parties' services offer goods and services to both businesses and consumers. Further, both parties' services are defined broadly so as to reasonably include as prospective purchasers all general consumers, whether for business or personal use. We are not persuaded by applicant that these are "sophisticated"

consumers; or that access to the Internet is limited, as it is common knowledge that computers are now available to all members of the public through public libraries. Thus, we conclude that applicant's recited services are the same as, or at least substantially similar to, those services in the cited registration.

Turning to consider the marks, we note that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). The question before us is whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

The examining attorney contends that the marks are substantially similar in sound, appearance, connotation and commercial impression because they share the common elements E and SHOP in that order, as ESHOP or E SHOP; and that the addition of the term PLANET to applicant's mark does not distinguish the marks.

Applicant contends that "the respective marks are not identical in appearance or sound" [Brief, p. 4] and "have different connotations" [Brief p. 6]; that "the registered mark is the merged conjunction ESHOP, the simple combination of two generic terms" [Brief p. 5] and these terms "are in widespread use as generic descriptors of electronic commerce business operations"⁴ [Brief p. 6]; that the examining attorney has improperly dissected applicant's mark; and that the term PLANET easily distinguishes its mark from the registered mark. Acknowledging that foreign registrations have no precedential value in this proceeding, applicant submitted copies of its foreign registrations to show "the worldwide, universal recognition and acceptance of the meaning of the letter "E" and "SHOP" in the context of electronic commerce or e-commerce...." [Brief, p. 7.] Additionally, applicant submitted copies of several third-party registrations that include the term SHOP and several

⁴ Applicant's allegation that the elements "E" and "SHOP" are generic constitutes an attack on the validity of the cited registration that is inappropriate in this ex parte appeal. Rather, such a claim should be made in the context of a petition to cancel the cited registration.

excerpts from third-party Internet web pages that use the term ESHOP or E SHOP.

Applicant asks us to give little weight to the fact that both marks involved herein include the terms "E" and "SHOP," and to focus on the additional word PLANET in its mark to reach a conclusion that the marks are not likely to cause confusion. As previously noted, applicant's assertion that registrant's mark ESHOP is generic is not appropriate in this ex parte appeal and the Board has not considered this argument.

"E" is a prefix that is generally recognized as meaning "electronic" in connection with computers and the Internet. *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000). We take judicial notice of the definition of "shop" as "n. 4.a. a commercial or industrial establishment, b. a business establishment" and "v. 1. to visit stores for the purpose of inspecting and buying merchandise."⁵ These definitions and applicant's evidence of several apparent third-party uses of the term E SHOP or ESHOP in connection with retail internet sites, lead us to conclude that the registered mark, ESHOP, is suggestive in connection with the identified services. This suggestiveness diminishes the scope of protection accorded to the cited registration. See, *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910 (TTAB 1988).

⁵ *The American Heritage Dictionary*, 2nd College Edition, 1985.

Nonetheless, weak marks are entitled to protection and, in this case, applicant has usurped registrant's mark in its entirety⁶ and simply prefaced it with the word PLANET, which may be considered suggestive of the scope of applicant's services.

Therefore, we conclude that the commercial impressions of applicant's mark, PLANET E SHOP, and registrant's mark, ESHOP, are sufficiently similar that their contemporaneous use on the same services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

In view of the weakness of the registered mark, we admit that our conclusion that confusion is likely is not without doubt. However, we are obligated to resolve such doubt in favor of the registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988).

Decision: The refusal under Section 2(d) of the Act is affirmed.

⁶ While the registered mark merges the terms E and SHOP into ESHOP and applicant separates the two terms, we find this difference negligible and find the commercial impression of ESHOP and E SHOP to be the same.